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EXAMINER	
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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 34

Application Number: 09/441,289
Filing Date: November 16, 1999
Appellant(s): SUHY ET AL.

Michael B. Stewart, Reg. No. 36, 018 and Christopher J. Falkowski, Reg. No. 45,989
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 11 September 2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct. However, the Examiner takes issue with the Appellant's assertions regarding the patentability of claim 16. Specifically, in an attempt to expedite prosecution, the Examiner suggested to the Appellant language that *best represents and most clearly defines* the Appellant's invention. This included language from the *Specification* as well as claim 21. However, the Appellant only added the limitations from claim 21. The Examiner made a courtesy call to the Appellant pointing out the omission, but the Appellant felt that the language from claim 21 was sufficient. The Examiner then performed a search and found art the Examiner feels when combined renders the Appellant's claims obvious to one of ordinary skill.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 16 and 43-48, claims 21-24, 27-35 and 38-42, claims 25, 26, 36 and 37 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,141,629	YAMAMOTO et al.	10-2000
6,003,808	NGUYEN et al.	12-1999
4,404,639	MCGUIRE et al.	09-1983
6,012,045	Barzilai et al.	6,012,045

Ira Sager, (May 18, 1994), Business Week,

wysiwyg://19/htp://www.businessweek.com/1998/35/z3372007.htm

Deierlein, Bob, Beverage World v113n1566 PP: 138 May 1994 ISSN: 0098-2318 "New Lease on truck life: Automated Maintenance"

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

Claims 16 and 43-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al., U.S. Patent No. 6,141,629 in view of Ryder's Fast Track Maintenance Service (Beverage World "New lease on truck life: Automated maintenance" by Bob Deierlein and Business Week "The Great

Equalizer" by Ira Sager), Nguyen et al., U.S. Patent No. 6,003,808 and McGuire et al., U.S. Patent No. 4,404,639.

As per claim 16 and 43-47, Yamamoto et al. teach transmitting data to an administrative controller (figures 10-12) that manages and controls maintenance information on all construction machines (column 9, lines 5-18) and determining when service should be performed based on the amount of usage (column 2, lines 1-13). Yamamoto does not explicitly recite warranties. Ryder Commercial Services and Leasing, however, has developed an automated vehicle maintenance service comprising comparing the indication of the amount of usage of the asset with a predetermined standard that is representative of the warranty period ("New lease...", page 2, lines 10-15), transmitting asset usage data to a central controller using a hand-held device ("New lease...", page 1, lines 22-37),. Both systems recite transmitting maintenance data to a computer after maintenance is performed ('629, column 11, lines 16-24; "New lease...", page 1, lines 45-50). Ryder also teaches entities that perform service on an asset where the entity is not the owner, and/or doesn't operate the asset ("The Great Equalizer", page 1, lines 5-10). Neither, Yamamoto et al. nor Brazilai et al. explicitly recite warranty reports or invoice generation. Regarding generating a warranty report, Nguyen et al. teach a warranty report generated without human intervention if the amount of usage is less than a predetermined standard (column 4, lines 50-61). As part of the report generating process the system of

Nguyen et al. compares an indication of the amount of usage of the asset with a predetermined standard that is representative of the warranty period (column 4, lines 32-49). McGuire et al. teach automated invoicing, in response to third-party maintenance, that includes the amount of usage of an asset (column 2, lines 14-41; column 3, lines 52-63; column 4, lines 3-31; column 5, lines 1-58; column/line 8/65-9/41). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Yamamoto et al., Ryder, Nguyen et al., and McGuire et al. in order to reduce time lost due to capital equipment failures and part procurement through the automatic recording of maintenance actions by maintenance personnel and the validating and/or generating of warranty claim applications ('308, column/line 1/65-2/2).

As per claim 48, it would have been obvious to repair an asset without referring to a warranty if the communication system was down and the maintenance data could not be obtained instantly.

Claims 21-24, 27-35 and 38-42 rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamota et al., U.S. Patent No. 6,141,629, Brazilai et al., U.S. Patent No. 6,012,045, Nguyen et al., U.S. Patent No. 6,003,808 and McGuire et al., U.S. Patent No. 4,404,639..

As per claims 21-24, 27-35 and 38-42, Yamamota et al. teach:

- a local controller at a first location that acquires data regarding

operating characteristics of an asset (figure 12; column 4, lines 30-50)

- a data acquisition device (column 4, lines 20-29)
- a transmitter (figure 12; column 4, lines 45-50)
- a second controller at an alternative location for data analysis, in particular to determine whether maintenance to an asset has taken place (figure 12, item 20; column 4, lines 44-50; column 9, lines 18-23; column 11, lines 17-23; column 11, lines 49-55; column 12, lines 54-57)
- an electronic communications network between the local controller and second controller (figure 12; column 4, lines 44-50)
- wireless communication between transmitter and receiver (figure 12, items A-I; column 8, lines 51-61)
- an administrative controller that receives data from the second controller (figure 12; column 9, lines 5-18)
- a global communications network that links the second controller and administrative controller (figure 12; column 9, lines 18-23)
- automatic determination as to whether maintenance has been performed on an asset (column 13, lines 4-12)
- a plurality of administrative controllers (figure 12, items 50-60; column 9,lines 5-23)

Yamamoto et al. do not teach automatic determination of whether or not maintenance has been performed at the analysis controller or systematic collation of data to obtain warranty data. Barzilai et al. teach an internet site for obtaining warranty information. In particular, Barzilai et al. use the internet to automatically provide users with suppliers and manufacturers for products and services and identifies the company who will fulfill and correct any warranty problem and its location (column/line 8/49-9/35). Regarding the analysis controller, it would have been obvious to one of ordinary skill to allow the analysis controller to perform such a function. Yamamoto et al. teach that the analysis controller is linked via a communication network to the administrative controller (column 9, lines 18-30) that monitors maintenance related data (column 9, lines 5-18; column 13, lines 4-12). Neither, Yamamoto et al. nor Brazilai et al. explicitly recite warranty reports or invoice generation. Nguyen et al. teach a warranty report generated without human intervention if the amount of usage is less than a predetermined standard (column 4, lines 50-61). As part of the report generating process the system of Nguyen et al. compares an indication of the amount of usage of the asset with a predetermined standard that is representative of the warranty period (column 4, lines 32-49). McGuire et al. teach automated invoicing, in response to third-party maintenance, that includes the amount of usage of an asset (column 2, lines 14-41; column 3, lines 52-63; column 4, lines 3-31; column 5, lines 1-58; column/line 8/65-9/41). Therefore, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Yamamoto et al., Brazilai et al., Nguyen et al., and McGuire et al. in order to reduce time lost due to capital equipment failures and part procurement through the automatic recording of maintenance actions by maintenance personnel and the validating and/or generating of warranty claim applications ('308, column/line 1/65-2/2).

As per claims 25, 26, 36 and 37, Yamamoto et al. teach analysis, local and administrative controllers that communicate using wireless and global communication networks and where the administrative controller is configured to manage and control maintenance information (figure 12; column 9, lines 5-35). Barzilai et al. teach an internet site for obtaining warranty information. In particular, Barzilai et al. use the internet to automatically provide users with suppliers and manufacturers for products and services and identifies the company who will fulfill and correct any warranty problem and its location (column/line 8/49-9/35). Regarding generating a warranty report, Nguyen et al. teach a warranty report generated without human intervention if the amount of usage is less than a predetermined standard (column 4, lines 50-61). As part of the report generating process the system of Nguyen et al. compares an indication of the amount of usage of the asset with a predetermined standard that is representative of the warranty period (column 4, lines 32-49). McGuire et al. teach automated invoicing, in response to third-party maintenance, that includes

the amount of usage of an asset (column 2, lines 14-41; column 3, lines 52-63; column 4, lines 3-31; column 5, lines 1-58; column/line 8/65-9/41). Therefore, it would have been obvious for one of ordinary skill in the art to combine the teachings of Yamamoto et al., Barzilai et al., Nguyen et al. and McGuire et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Yamamoto et al., Brazilai et al., Nguyen et al., and McGuire et al. in order to reduce time lost due to capital equipment failures and part procurement through the automatic recording of maintenance actions by maintenance personnel and the validating and/or generating of warranty claim applications ('308, column/line 1/65-2/2).

(11) Response to Argument

Claim Group A

The Appellant asserts that the prior art does not teach the following elements of claim 16: "analysis controller", "data acquisition device", "receiver", "transmitter", "administrative controller" and "communications network" (Brief on Appeal, page 7, second paragraph). In the Final Office Action (Paper no. 29, page 3, lines 3-7), the Examiner refers to figure 12 in the Yamamoto et al. reference. The reference details heavy machines at a site ('629, figure 12, items 10-13) ***wirelessly*** (i.e. through space) transmitting performance data to a first computer or "analysis controller" ('629, figure 12,

items 20 and 21). This computer or "analysis controller" monitors a set of assets, hence it is analogous to the central computer of Ryder Fast Track Maintenance Service ("New lease...", page 1, lines 22-37), the control system of Nguyen et al. ('808, abstract), and the network computer of McGuire et al. ('639, figure 1). Each heavy machine is a data acquisition device as it collects machine data and, using a transmitter, sends the data to the computer. In order to receive the sent data, the computer must have a receiver (note the antennae atop the station (item 20)) and, giving the term "receiver" its broadest reasonable interpretation the computer is itself a "receiver" ('629, column/line 8/27-9/5). The computer (items 20 and 21) is in connection with a global managing computer (i.e. an administrative controller) (items 50-60) that controls and manages maintenance information on all construction machine manufacturers throughout the world ('629, column 9, lines 5-30). To one of ordinary skill maintenance information comprises invoice, warranty, service performed data, etc., therefore, it is at least obvious that the system of Yamamoto et al. processes invoice and warranty data. According to *Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966),* one of the steps in determining obviousness is to resolve the level of ordinary skill in the pertinent art. Therefore, the Examiner feels it is unacceptable to expect one of ordinary skill to be ignorant of the existence of third party and other maintenance practioners such as Meineke, NTB, Jiffy Lube, car dealerships, Sears and their processing of warranties (e.g. "Is this covered by my warranty?") and invoices (Problem cannot be approached on the basis that workers in the art would know only what they could read in references;

those skilled in radiator art must be presumed to know something about radiators apart from what references disclose- In re Jacoby, 135 USPQ 317 (CCPA 1962)). With this in mind, the Appellant is of the opinion that the distinguishing feature between the prior art and the Appellant's claimed invention is that the Appellant performs processes such as "generating an invoice" without human intervention (Brief on Appeal, pages 8-13- claims 16, 21, 25, and 31). However, it has been held that automating a known process is an obvious modification and within the level of one of ordinary skill (*In re Venner,* 262 F.2d 91, 95, 120 USPQ 192, 196 (CCPA 1958)). Specifically, In re Venner and Bowser states

> However, appellants do contend that the *basis for allowance* of the appealed claims resides in the combination of the old permanent-mold structures together with a timer and solenoid which automatically actuates the known pressure valve system to release the inner core after a predetermined time has elapsed.
>
> if a new combination of old elements is to be patentable, the elements must cooperate in such manner as to produce a new, unobvious, and unexpected result. It must amount to an invention. In re Smith, 34 CCPA 1007, 73 USPQ 394 , cited supra. In [3] the absence of invention, utility and novelty are not sufficient to support the allowance of claims for a patent. In re Levin, 37 CCPA 791, 178 F.2d 945, 84 USPQ 232 ; In re Hass et al., 31 CCPA 895, 141 F.2d 122,
>
> It follows naturally that if the timers are employed the instantaneous reaction which appellants deem so important, would result.

Therefore, given the knowledge of one of ordinary skill and the teachings of the cited prior art, the Appellant's claims with the mere limitation of performing a task "without human intervention" does not produce an unobvious and unexpected result and hence, the claim is not allowable.

The Appellant also disputes the teachings of the prior art regarding "an entity performing service on the asset" that "is not the owner" (Appellant's claim 43). The Appellant states that the Sager, Business Week article fails to disclose such a teaching. The Examiner respectfully disagrees. The Sager article refers to trucks owned by Ryder System Inc., however, the technician performing the service is Karen Reinecke who is clearly not the owner of the asset (i.e. the Ryder truck).

The Appellant also disputes the teachings of the prior art regarding the limitation of "wherein service must be performed on an asset before the amount of usage of the asset is compared to the predetermined standard" (Appellant's claim 48). Claims 16 and 43-48 are rejected by the combined prior art of Yamamoto et al., Ryder's Fast Track Maintenance Service (Sager and Deierlein), Nguyen et al. and McGuire et al.. Claim 16 recites "generating a maintenance invoice from an analysis controller when service is performed on the asset, wherein the maintenance invoice includes an indication of the amount of usage of the asset". McGuire et al. teach automatically generating an invoice that comprises an indication of the amount of usage of an asset (e.g. mileage), where the invoice can be generated at any time during servicing and generating an invoice after the completion of a work order ('639, column 5, lines column 8, lines 65-68; column 9, lines 15-28- paper no. 29, page 4, lines 3-5). McGuire et al. also teach that the invoice includes "warranty number". Hence, to one of ordinary skill this is used to look up a warranty to compare maintenance with the terms of the warranty (i.e. predetermined standard that is representative of the warranty period). While Nguyen et

al. teach generating a warranty report if the amount of usage is less than the predetermined standard ('808, column 4, lines 56-67)

The Appellant disputes the Examiner's motivation to modify or combine the teachings of the prior art. Initially, the Examiner would like to point out that the Examiner used four references (note both Sager and Deierlein articles are dedicated to Ryder's Fast Track Maintenance System and the mention of Brazilai et al. was a typo). However, regarding the number of references *In re Gorman* is clear:

> Patent and Trademark Office's reliance on teachings of large **number of references** in rejecting patent application for obviousness does not, without more, weigh against holding of obviousness on appeal, since criterion is not number of references, but whether references are in fields which are same as or analogous to field of invention, and whether their teachings would, taken as whole, have made invention obvious to person skilled in that field." *In re Gorman*, 18 USPQ2d 1885 (CAFC)

Hence, the proper question regarding the combination is "whether references are in fields which are same as or analogous to field of invention" as we have already seen that each limitation is explicitly recited in the prior art. Yamamoto et al. teach a system for managing maintenance information ('629, column 9, lines 5-18). Ryder teaches an automated vehicle maintenance service comprising comparing the indication of the amount of usage of the asset with a predetermined standard that is representative of the warranty period ("New lease...", page 2, lines 10-15) and transmitting asset usage data to a central controller using a hand-held device ("New lease...", page 1, lines 22-37). McGuire et al. teach performing maintenance and generating invoices ('639, column/line 4/32-5/30; column/line 8/65-9/40) and Nguyen et al. teach comparing

services performed with a warranty record and generating a report if it is determined that the actions are covered by the warranty ('808, column 4, lines 32-67). Hence, to one of ordinary skill all of the references are in the same or at least analogous field of invention.

In re Venner and Bowman is clear,

> if a new combination of old elements is to be patentable, the elements must cooperate in such manner as to produce a new, unobvious, and unexpected result. It must amount to an invention. In re Smith, 34 CCPA 1007, 73 USPQ 394 , cited supra. In [3] the absence of invention, utility and novelty are not sufficient to support the allowance of claims for a patent. In re Levin, 37 CCPA 791, 178 F.2d 945, 84 USPQ 232 ; In re Hass et al., 31 CCPA 895, 141 F.2d 122

Claim Group B

The Appellant merely rehashes Appellant's arguments regarding the analysis controller, data acquisition device, transmitter, receiver and an administrative controller. However, in the "analysis controller" and "local controller" of claim 21 correspond to the "administrative controller" and "analysis controller" of claim 16. Yamamoto et al. teach a system for managing and controlling a global fleet of heavy machines comprising: manned or unmanned heavy machines at a site ('629, figure 12, items 10-13) ***wirelessly*** (i.e. ***through space***) transmitting performance data to a first computer ('629, figure 12, items 20 and 21) wherein each heavy machine is a data acquisition device as it collects machine data and, using a transmitter, and sending the data to the "local" computer. In order to receive the sent data, the computer must have a receiver (note the antennae atop the station (item 20)) and, giving the term "receiver" its broadest

reasonable interpretation the computer is itself a "receiver" ('629, column/line 8/27-9/5). The "local" computer (items 20 and 21) is in connection with a ***remote*** global managing computer (i.e. an administrative controller or analysis controller) (items 50-60) that controls and manages maintenance information on all construction machine manufacturers throughout the world ('629, column 9, lines 5-30).

Regarding motivation to combine Yamamoto et al., Nguyen et al., McGuire et al. and Brazilai et al., it would have been obvious to provide service personnel with a centralized location for retrieving maintenance information such as via a website ('045, column/line 8/49-9/35). Is the Brazilai et al. teaching in the same field of invention? Not necessarily, however, they do teach maintenance information (e.g. product warranties) which is a common thread that runs through the Yamamoto et al., Nguyen et al., and McGuire et al. teachings. Further, one of ordinary skill when trying to solve a data processing problem would not limit her/his/their search to their native field of endeavour. On the contrary, he/she/they would search for solutions to the problem, hence when trying find a way of disseminating maintenance data or making maintenance data available, one would search for technical solutions to said issue. Brailzai et al. provide one such solution as they teach websites for providing maintenance related information. Also note, it would have been obvious to one of ordinary skill to obtain the heavy machines (Yamamoto et al.), airplanes (Nguyen et al.) and/or cars (McGuire et al.) by auction (figures 1, 3, 4A-B).

Claim Group C

Regarding the "procurement" or "utilization", the claim specifically recites a computer "configured to generate management reports relating to the procurement and utilization of the asset" and not creating "procurement" or "utilization" reports as the Appellant suggests (Brief on Appeal, page 21, section 1, lines 2). The Appellant is attempting to limit the claim (25 and 36) by relying on the phrase "... relating to the procurement and utilization of the asset". It has been held that nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Specifically, a computer or system that differs from the prior art solely with respect to the data being manipulated and the data does not alter how the computer or system performs a task or function, said data is non-functional. The Appellant is attempting to distinguish the Appellant's claims from the prior art (Nguyen et al., column 4, lines 50-61) by the data being processed, however,

> [Information is] The meaning of data as it is intended to be interpreted by people. Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what the data represents (Microsoft Press Computer Dictionary Third Edition, page 249)

Therefore, claims 25, 26, 36 and 37 are obvious in light of the prior art of Yamamoto et al., Nguyen et al., Brazilai et al. and McGuire et al..

(12) Conclusion

Appellant's arguments are not persuasive in that they do not give fair credit to the level and knowledge of those of ordinary skill and what would have been rendered obvious when the prior art is presented to one of ordinary skill. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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December 8, 2003

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